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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/772,674 | 02/04/2004 | Marc Ira Lipton | 8285/671 | 5600 |
| 7590 | 01/25/2008 | | EXAMINER | |
| Peter C. Breen BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610 | | | SING, SIMON P | |
| | | | ART UNIT | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/772,674 | LIPTON ET AL. |
| | Examiner | Art Unit |
| | Simon Sing | 2614 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 October 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 34-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 34-57 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date: _____
- 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 34-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al. US 5,819,029 in view of O'Neal et al. US 5,887,253.

1.1 Regarding claims 34 and 46, Edwards discloses a third party verification system in figure 1, comprising:

a receiver (a telephone interface in the system controller 112) associated with a third party verification (TPV) service to receive, during a telecommunication call, a reply message to confirm an authorized switching to a new long distance service (a telephone service inherently has term and condition) (column 9, line 41 to column 10, line 63; column 12, lines 59-67);

a processor (system controller 112) in communication with the receiver; a database (IVR response repository 114) in communication with the processor; and

wherein the processor creates a record in the database, including audio recordings of affirmative acceptance of the long distance service (column 13, line 66 to column 14, line 23; column 15, lines 27-61).

Edwards teaches verifying, without a service contract, a switch to another a long distance telephone service provider. Edwards is silent on the terms and conditions of a contract.

However, O'Neal teaches a voice response unit (VRU) for playing a pre-recorded voice messages (prompts) concerning terms and conditions of a mobile telephone service to a potential customer, and recording responses from the customer. O'Neal teaches prompting the customer, without a contract, to accept terms and conditions, charges and payment, and other contract related provisions (column 13, lines 19-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Edwards' reference with the teaching of O'Neal, so that terms and conditions prompts would have been played to and accepted by a customer without a contract, because such a modification would have provided proof that a customer understood and approved the terms of a new service.

1.2 Regarding claim 35, Edwards teaches that a spoken reply message indicates an acceptance of a telephone service (column 10, lines 43-55, 61-63; column 12, lines 64-67).

1.3 Regarding claims 36 and 47, Edwards teaches recording a subscriber's identity information (column 14, lines 1-2).

1.4 Regarding claim 37, Edwards teaches indicating a service provider identity (column 10, lines 49-51; column 12, lines 64-67).

1.5 Regarding claim 38, Edwards teaches timing information of a call (column 6, lines 44-46).

1.6 Regarding claim 39, Edwards teaches the identity of a calling party (telemarketer) (column 10, lines 11-15).

1.7 Regarding claims 40 and 48, Edwards teaches recording a customer's responses to verification prompts (column 10, lines 61-64).

1.8 Regarding claims 41, 49 and 50, it is inherent that by law, a service provider is required to mail a customer a printed copy of terms and conditions of a service contract (see US 3,999,700, column 3, lines 28-33).

1.9 Regarding claims 42 and 51, Edwards teaches a verbal service message (column 10, lines 49-51; column 12, lines 64-67).

1.10 Regarding claims 43 and 52, Edwards teaches a long distance telephone service (column 10, lines 49-51; column 12, lines 64-67).

1.11 regarding claims 44 and 53, Edwards teaches a voice call initiated by a telemarketer (column 9, lines 41-51).

1.12 Regarding claim 45, Edwards teaches conferencing a telemarketer with the verification process, and in that the telemarketer may speak to the customer on intervene at any time (column 10, lines 24-28).

1.13 Regarding claims 54-57, Edwards teaches prompting a customer to say 'yes' or 'no' to a long distance telephone service (column 12, lines 64-67).

Response to Arguments

2. Applicant's arguments filed on 10/30/2007 have been fully considered but they are not persuasive.

Applicant argues that Edward and O'Neal fail to teach the claimed limitation of: "wherein the terms and conditions are accepted without a contract".

As stated in the rejection above, Edward teaches, without a service contact, prompting a customer to verify an acceptance of a communications service. O'Neal teaches verifying, without a contract, an acceptance of terms, condition and other contract provisions. Therefore, both Edwards and O'Neal teach accepting terms and conditions of a service without a contract.

Conclusion

3. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.



S. Sing

01/16/2008